

REMARKS/ARGUMENTS

Claims 60-64 are pending in this application.

I. Rejections under 35 U.S.C. § 102(b):

(a) Claims 60-64 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Makrigiorgus (U.S. Patent No. 6,174,680) (see, Office Action, page 3). The Examiner relies on this patent for teaching the Affymetrix Hu6800 DNA chip which he alleges comprises “all of the structural constraints in Claims 60-64.”

Applicant respectfully traverses this rejection.

According to MPEP § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

First, Applicant notes that Applicant is not claiming the Hu6800 Affymetrix array. Applicant further notes that there is no teaching or suggestion in Makrigiorgus of Applicant’s claimed invention because nowhere in this reference patent is there any teaching or suggestion that Hu6800 comprises the nucleic acid molecules selected from the groups consisting of: (i) a first response group comprising at least one nucleic acid molecule encoding a transcription factor protein, at least one nucleic acid molecule encoding a signal transducing protein, and at least one nucleic acid molecule encoding a mitochondrial protein; (ii) a second response group comprising at least one nucleic acid molecule encoding a secreted growth factor, at least one nucleic acid molecule encoding a cytokine, and at least one nucleic acid molecule encoding a chemokine; and (iii) a third response group comprising at least one nucleic acid molecule encoding an actin-binding protein, at least one nucleic acid molecule encoding a desmosomal protein, and at least one nucleic acid molecule encoding a tubulin protein. In the absence of this teaching, Makrigiorgus does not anticipate Applicant’s claimed invention because this patent does not teach each and every element of Applicant’s claimed invention.

Thus, Applicant respectfully requests that this rejection under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

(b) Claims 60-64 are rejected under 35 U.S.C. § 102(b) as purportedly being anticipated by Affymetrix Technical Note (2004) because this Note allegedly evidences that Hu6800 was in public use or on sale in this country in 1998, which is more than one year prior to the priority date of the instant application. (*see*, Office Action, page 3).

Applicant traverses this rejection for the reasons outlined above. Again, Applicant notes that the claims are directed to a specific set of nucleic acid molecules whose altered expression is indicative of a cell's exposure to ultraviolet radiation. There is no teaching or suggestion in Affymetrix Technical Note (2004) that the Affymetrix Hu6800 chip sold in 1998 comprises the specific nucleic molecules recited in claim 60.

Thus, because the Technical Note does not teach each and every element of Applicant's claimed invention, this Note does not anticipate Applicant's claimed invention.

Accordingly, Applicant respectfully requests that this rejection under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

CONCLUSION

Claims 60-64 are pending in the instant application.

Applicant respectfully avers that all rejections of these claims have been overcome and that these claims are in condition for allowance.

No fees are due in connection with this filing; however, if any fees are due, please charge any underpayments, or credit any overpayment to our Deposit Account No. 08-0219.

If there are any questions regarding this matter, the Examiner is invited to call the undersigned at the telephone number indicated below.

Respectfully submitted,

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